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Case 7496RC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of ::
BARRY S. SHANTZ, et al. ::
Serial No. 09/334,695 :: Group Art Unit 1615
Filed June 25, 1999 :: Examiner S. Tran
For PRE-MOISTENED WIPE WITH LOTION TO IMPROVE DISPENSING

PRELIMINARY AMENDMENT

Commissioner for Patents

Washington, D.C. 20231

Dear Sir:

This paper is being filed in response to the Office Action mailed January 29, 2001. A three-month extension of time is being filed herewith. Reconsideration and reexamination are respectively requested in light of the remarks filed below.

Rejections Under 35 USC §103

1) Luu

Claims 1-16 have been rejected under 35 U.S.C. §103 as being obvious over Luu et al., US Patent No 5,871,763. It is the Examiner's contention that that the claimed pre-moistened wipes are obvious in light of what is taught by Luu. Applicants respectively traverse the rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP706.02(j); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP Section 2143 - Section 2143.03.

As it was noted in Applicants' previous response, the Examiner has failed to establish a prima facie case of obviousness. Luu limits the amount of water, if any is present, in the lotion to "about 15% or less"; typically "with minor amounts of water" that is "present due to ambient humidity". See Column 3 line 66- Column 4 line 23. Luu provides teaching, suggesting and motivation to one of ordinary skill to use an anhydrous lotion with minimal water, if any, and instead teaches away from lotion containing a substantial amount of water. Contrast this teaching in Luu with the position taken by the Examiner that a lotion containing "about 15% or less water" is equivalent to a lotion with a greater than 50% water content. The Examiner argues that the difference is insignificant and would be obvious to one of ordinary skill that would "by routine experimentation determine a suitable amount of water and suitable amount of antimicrobial agent".

With all respect to the Examiner, this is just plain wrong.

The question the Examiner has failed to address is why would one of ordinary skill add water to the composition of Luu. Luu provides teaching of the problems associated with elevated water content. Column 4, lines 6 to 23. Luu teaches that a water free or low water content lotion provides improved storage and handling. Column 4, lines 6 to 9. Additionally, Luu teaches that increasing the amount of water increases the viscosity of the lotion. Column 4, lines 14 to 23. In other words there is no teaching, motivation or suggestion provided in Luu or by the Examiner as to why one of ordinary skill would add water to the composition of Luu. In effect, the Examiner is asking one of ordinary skill on the one hand to follow the teaching of some parts of Luu while on the other hand ignore other teaching of Luu, specifically that which teaches away from what the Examiner is asserting one of ordinary skill would do. The Examiner has failed to show any motivation, suggestion or teaching as to why one of ordinary skill would disregard

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the clear teaching in Luu regarding the desirability of anhydrous lotions and change from an oil based lotion to an aqueous one. In reality, Luu provides motivation, suggestion and teaching for one of ordinary skill of the exact opposite of what is being asserted by the Examiner, namely to exclude water entirely.

The Examiner has noted that it would be obvious to one of ordinary skill to determine a suitable amount of water and a suitable amount of antimicrobial agent. However, this provides no additional motivation to increase the amount of water present. All this teaches is that if water is present an antimicrobial agent may be required, and the more water present the more likely that an antimicrobial agent will be required. So Luu is teaching one of ordinary skill that if a lotion has about 15% water it is more likely to contain an antimicrobial agent than a lotion with a water content of about 5% or about 1%. This teaching provides no additional motivation, or suggestion to one of ordinary skill to increase the water content above the water limitation of 15% in Luu. The teaching on antimicrobial agents only teaches one of ordinary skill how to stabilize some compositions of Luu. The Examiner has still failed to address the basic issue, namely why would one of ordinary skill add water to the composition of Luu. Net the Examiner has failed to establish the first part of the three-part test for the establishment of a prima facie case: motivation to modify the cited reference.

Said another way, the Examiner has failed to show any motivation, suggestion or teaching as to why one of ordinary skill would disregard the teaching in Luu and change from a substantially anhydrous lotion to an aqueous one. The Examiner is attempting to use the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986), and In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Why would one of ordinary skill add water to the composition of Luu when the only teaching in Luu is of the problems associated with doing this?

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In light of the foregoing remarks, it is requested that rejection of Claims 1-16 be reconsidered and withdrawn.

2) Luu U.S. 5,781,763 in view of Blieszner and Muckenfuhs

Claims 1-20 are rejected under 35 U.S.C. §103 as being obvious over Luu et al., US Patent No 5,871,763 in view of Blieszner et al., US Patent No 5,648,083 and Muckenfuhs, US Patent No 5,332,118. It is the Examiners contention that that the claimed pre-moistened wipes are obvious in light of what is taught by Luu in view of Blieszner and Muckenfuhs. Applicants respectively traverse the rejection.

Applicants above have shown that Luu alone does not teach one of ordinary skill Applicants' present invention. Furthermore, the teaching pointed to specifically by the Examiner in Blieszner and Muckenfuhs does not provide any additionally teaching to overcome the fundamental difference between Applicants invention and Luu.

The teachings from Blieszner and Muckenfuhs provide no additional motivation or suggestion to one of ordinary skill to that of Luu. As the Examiner is well aware, any obviousness objections based on a combination of prior art references, such as in the present situation, there must be some teaching, suggestion, or motivation to combine the references. See In re Rouffet 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir.1998). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). There is no such teaching, suggestion, or motivation to combine any of the references in the present situation. Firstly, the Examiner has provided no motivation for the combination of Luu and Blieszner. Luu is wholly silent as to an aqueous based lotion and specifically teaches away from such, whereas Blieszner is solely directed to aqueous wipes. This means to combine these two citations one of ordinary skill would have to ignore specific teaching in Luu, to limit the water content of the lotion to about 15%, or less, preferably free of water. Instead, Luu provides teaching, suggestion and motivation for one of ordinary skill to not combine with Blieszner.

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Secondly, both Luu and Blieszner make no mention of any type of dispensers, let alone pop-up dispensers. And, as the Examiner is well aware there are a plethora of possible dispensers for a wipe. Some possible examples of types of dispensers include, but are not limited to, rolls, individual satchels, reach in dispensers and pop-up dispensers. There are a large number of variations of each of these different types of dispensers. There is no suggestion or teaching in either of Luu or Blieszner that any dispenser one is preferable any other. Consequently, there is no motivation, suggestion or teaching in either Luu or Blieszner for one of ordinary skill to combine either with Muckenfuhs. Similarly, in Muckenfuhs there is no motivation, teaching, or suggesting that water or aqueous based lotion is any better than oil based lotion. As a matter of fact Muckenfuhs even teaches that a powder is on equal footing with any lotion. See Muckenfuhs column 10, lines 55-56. Muckenfuhs provides no motivation for one of ordinary skill to combine its teaching with that of either Luu or Blieszner.

The Examiner is attempting to use the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q. 2d 1081 (Fed. Cir. 1986). The prior art references must provide some motivation for their selection by the artisan. Furthermore, there must always be a reasonable expectation of success to the selection and, no such reasonable expectation exists in the present situation. See In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In light of the amendments to the claims and the foregoing remarks, it is requested that rejection of Claims 1-20 be reconsidered and withdrawn.

Conclusion.

In light of the amendments and remarks presented herein, Applicants respectively submit that Claims 1-20 are allowable over the prior art of record or any combination thereof. In the event that issue remain prior to allowance of the noted

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